REMARKS/ARGUMENT

Claims 1-23, and 35-36 are pending in the present application following entry of the present Amendment. Independent claims 1, 12, and 20 are herein amended as described below. Claims 24-34 are herein canceled. New claims 35 and 36 are herein submitted for examination. New claims 35 and 36 recite the feature of enabling access to any device connected to the host adapter system which includes providing for configuration and management of any device connected to the host adapter. Examiner is kindly directed to, for example, the specification as filed at page 18, lines 15-18, and Figures 3H and 3I for support of the features recited in new claims 35 and 36. Applicant respectfully submits no new matter is introduced.

Rejections under 35 USC §102

Claims 1-3, 8-18, 20-22 and 27-33 were rejected under 35 U.S.C. §102(b) as being anticipated by *Symbios Inc.*, PCI SCSI Device Management System SDMS 4.0, 1998 (*Symbios*). This rejection is respectfully traversed, and Applicant requests reconsideration in light of claim amendments and the following argument.

Applicant's independent claim 1, as amended herein, claims a method for managing a configuration of a host adapter for a computer. The host adapter allows communication between the computer and a peripheral device connected to the host adapter. The method includes generating a graphical user interface. The graphical user interface is configured to allow a user to access configuration settings of the host adapter. The method further includes managing the configuration settings of the host adapter by way of the graphical user interface to create configuration changes. The configuration changes are saved to a file in a storage location. Next, the method provides for rebooting the computer, and for reading the configuration changes saved to the file in the storage location. The reading is performed during the rebooting of the computer. Then, the configuration changes are written to a nonvolatile memory of the host adapter of the computer, and the configuration changes for the host adapter are activated during the rebooting of the computer. The method is implemented in and integrated with the operating system of the computer.

In independent claim 12, as amended herein, Applicant claims a method for accessing and managing a configuration of a host adapter for a computer. The host adapter provides

communication between the computer and a peripheral device connected to the computer. The method includes generating a graphical user interface, and accessing and managing the configuration of the host adapter by way of the graphical user interface. The accessing and managing of the configuration includes making changes to the configuration. The method further includes saving the changes to the configuration to a registry key, and then receiving a command to reboot the computer. The command to reboot the computer is executed, and a reboot operation is initiated. The method then provides for reading the changes to the configuration saved to the registry key during the reboot operation, and for writing the changes to the configuration to a nonvolatile memory of the host adapter of the computer. The method is implemented in and integrated with the operating system of the computer.

Finally, Applicants claim in independent claim 20, as amended herein, a method for enabling graphical user interface driven modifications of settings in an EEPROM associated with a SCSI host adapter connected to a computer. The method includes displaying a graphical user interface. The graphical user interface provides a list of selectable configuration options. The method further includes receiving user selections of change options provided by the list of selectable configuration options, and writing the user selections to a storage location. The method then provides for initiating a reboot of the computer, and for writing the user selections from the storage location to the EEPROM. The method further provides for completing the rebooting. The SCSI host adapter is configured to operate in accordance with the user selections. The method is implemented in and integrated with an operating system of the computer.

In order for a reference to anticipate a claim, each and every element as set forth in the claim must be found in the reference, either expressly or inherently described. MPEP 2131. Applicant respectfully submits that the *Symbios* reference fails to anticipate Applicant's independent claims 1, 12, and 20, as amended herein, and likewise fails to anticipate each of the dependent claims 2-3, 8-11, 13-18, and 21-22, depending therefrom.

The *Symbios* reference, in relevant sections, teaches a utility program for configuration and management of a *Symbios* SCSI host adapter. The utility program works in conjunction with the *Symbios* Windows NT Flint driver to provide limited impact on the system. As disclosed on page 5-24, "only a limited number of the configuration parameters that can be changed by this utility will have any impact on the system once rebooted. These parameters are: SCSI ID of the computer; wide data bits setting; and synchronous rate." Although a powerful tool in that it

enables some system level changes with regard to the *Symbios* host adapter and driver, the configuration utility is little more than the standard utility program that would be expected to ship with any card, board, or other hardware device to be configured to a computer system.

In the instant application, Applicant claims a method and system for enabling access to effect configuration and management settings and adjustments of a host adapter and of the devices connected thereto. The method is implemented in and integrated with the operating system, so access is enabled through such WindowsTM system applications as Control Panel, My Computer, Windows Explorer, and Internet Explorer. Just as any of a plurality of hardware components are "selectable" within these environments, hardware components such as modems, network interface cards, hard drives, optical media drives, and the like, embodiments of the present invention are implemented in and integrated with the operating system to enable access to the host adapter, as well as any device connected to the host adapter.

By way of example, a host adapter may be configured to a system and have three devices connected thereto (see Figure 3D of Applicant's application as filed). Embodiments of the present invention not only provide for access to the host adapter itself to manage, trouble shoot, and configure as necessary (See Figures 3D-3G), but also provide access to configure and manage the devices themselves which are connected to the host adapter (see Figures 3H and 3I). Further, since embodiments of the present invention are implemented in and integrated with the operating system, access is provided through a plurality of alternative routes such as, for example, Control Panel (see Figures 2A-2C), My Computer (see Figure 3A), Windows Explorer (see Figures 3B-3C), and Internet Explorer (see Figures 4A, 4B). Further, see Figure 5 as illustrative of the integration and implementation in the operating system. And, since embodiments of the present invention are implemented in and integrated with the operating system, *meaningful* configuration and management is possible.

The *Symbios* reference teaches a typical utility configuration program of limited value and narrow application. The *Symbios* reference does not teach a method as claimed by Applicant that is implemented in and integrated with the operating system. The *Symbios* reference therefore does not teach each and every element as set forth in Applicant's independent claims 1, 12, and 20, either expressly or inherently described.

Applicant further notes that claims 7 and 21 recite the feature of providing access to diagnostic tools for managing the configuration of the host adapter (claim 7) and selections to

initiate diagnostic testing of the SCSI host adapter (claim 21). Although claim 7 is rejected under 35 USC §103 addressed below, both claims recite a feature relating to diagnostic testing. The Office cites pages 24-32 of the reference, but Applicant respectfully submits that the reference fails to teach diagnostic tools or diagnostic testing. In Applicant's specification as filed, see, for example, line 19 on page 16 through line 20 on page 17, and Figures 3E and 3F, for specific examples of diagnostic tools and the diagnostic testing as claimed by Applicant in claims 7 and 21. Applicant is not suggesting that the reference should teach the same diagnostic examples, but that the reference teaches no diagnostic tools or diagnostic testing.

For at least the above reasons, Applicant submits that the *Symbios* reference fails to teach each and every element as set forth in Applicant's independent claims 1, 12 and 20, as amended herein. Consequently, the reference fails to teach each and every element of dependent claims 2-3, 8-11, 13-18, and 21-22, each of which depends, directly or indirectly, from one of independent claims 1, 12 and 20. Applicant therefore submits that the *Symbios* reference fails to anticipate Applicant's claims 1-3, 8-18, 20-22 as amended herein, and requests that the §102 rejection be withdrawn.

Rejections under 35 USC §103

Claims 4-7, 19, 23-26, and 34 were rejected under 35 USC §103(a) as being unpatentable over *Symbios* in view of *Sun*TM *StorEdge*TM (*Sun*), A5000 Installation Guide, for Windows NT Server 4.0. Applicant respectfully traverses this rejection, and requests reconsideration in light of claim amendments and the following argument.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the reference or in the knowledge generally available to one having ordinary skill in the art, to modify the reference. Additionally, there must be a reasonable expectation of success, and the reference when modified must teach or suggest all of the claim features. Modifications to prior art that are within the skill of one of ordinary skill in the art at the time of invention is insufficient to establish a *prima facie* case of obviousness without some objective reason to modify. The mere fact that a reference <u>can</u> be modified does not render the resultant modification obvious unless the prior art also suggest the desirability of the combination. (See MPEP §2143.)

In asserting the §103 rejection, the Office essentially states that the *Symbios* reference teaches all of the claimed features except for the use of an icon as recited in claims 4-7, 19 and 23. The *Sun* reference is used to modify the *Symbios* reference to incorporate the use of an icon, and for no additional feature, element, or purpose. Applicant respectfully submits that, even if the *Symbios* reference is modified as suggested, the reference still fails to teach or suggest all the claim features. As described above in reference to the §102 rejection, the *Symbios* reference fails to teach or suggest a method implemented in and integrated with the operating system. Further, the *Symbios* reference fails to teach or suggest the use of diagnostic tools and diagnostic testing as described above in reference to both claims 7 and 21.

For at least the above reasons, Applicant respectfully submits that the *Symbios* reference, as modified by *Sun*, fails to teach or suggest all the claim features of Applicant's independent claims 1, 12, and 20. Consequently, the *Symbios* reference, as modified by *Sun*, fails to teach or suggest all the claim features of Applicant's dependent claims 4-7, 19, and 23, each of which depends, directly or indirectly, from one of independent claims 1, 12 and 20. Applicant therefore requests that these rejections be withdrawn.

New Claims

Applicant herein submits new claims 35 and 36 for examination. Claims 35 and 36 are dependent claims, indirectly depending from independent claims 1 and 12, respectively, and positively reciting the feature that the access to any device connected to the host adapter includes providing for configuration and management of any device connected to the host adapter. As recited in the specification as filed at page 18, lines 14-17, "One embodiment of the present invention provides for accessing, configuration, and management of peripheral devices connected to a SCSI host adapter, in addition to the host adapter itself." Exemplary screens are illustrated in Figures 3G, 3H, and 3I. Applicant submits that the *Symbios* reference teaches a configuration utility that can effect changes to the configuration settings of the host adapter with regard to devices connected thereto, nothing in the reference teaches or suggests the ability to effect management and/or configuration of the peripheral device itself as claimed by Applicant. Applicant therefore respectfully submits that the new claims present no new matter, and are neither anticipated nor rendered obvious by the cited prior art.

Appl. No. 09/752,504 Amdt. dated June 23, 2004 Reply to Office Action of February 24, 2004

In view of the foregoing, Applicant respectfully requests reconsideration of claims 1-23, as amended herein, and examination of new claims 35 and 36. Applicants submit that all claims are in condition for allowance. Accordingly, a notice of allowance is respectfully requested. If Examiner has any questions concerning the present Amendment, the Examiner is kindly requested to contact the undersigned at (408) 749-6900, ext. 6905. If any additional fees are due in connection with filing this amendment, the Commissioner is also authorized to charge Deposit Account No. 50-0805 (Order No. ADAPP141). A copy of the transmittal is enclosed for this purpose.

Respectfully submitted, MARTINE & PENILLA, L.L.P.

Rick von Wohld, Esq. Reg. No. 48,018

MARTINE & PENILLA, LLP 710 Lakeway Drive, Suite 170 Sunnyvale, California 94085 Customer Number 25920